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The opinion in support of the decision being entered today was **not** written for publication
and is **not** binding precedent of the Board.

Paper No. 46

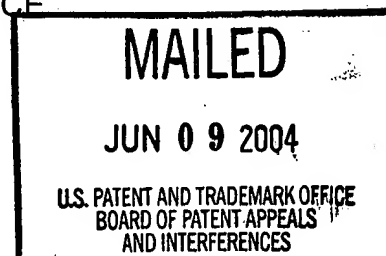
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER CONRAD and CHARLES BELL

Appeal No. 2002-1508
Application No. 08/421,810

ON BRIEF



Before FLEMING, DIXON, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 49-77,
79-80, 82-87, 89-90, 92-97, 99-100, which are all of the claims pending in this
application.

We REVERSE.

Appellants' invention relates to an intelligent locator system. An understanding of the invention can be derived from a reading of exemplary claims 49 and 72, which are reproduced below.

49. A locating and monitoring system installable on the premises of a facility, said system including:

a plurality of transmitter means adapted for movement about said facility with a person, with an animal or with equipment to allow identification of such transmitter means at any of diverse sites in the facility, each of said transmitter means including means for transmitting infrared pulse bursts, each of said infrared pulse bursts defining a unique binary identification code comprising a plurality of binary bits of sufficient number that each of said transmitter means in said facility transmits a different binary identification code, means responsive to an algorithm for controlling said means for transmitting said infrared pulse bursts during a predetermined time interval, with the occurrence of each pulse burst in time relative to the start of each time interval varying from time interval to time interval, the amount of said varying being controlled by said means responsive to an algorithm incorporated in each transmitter using said unique binary identification code of that transmitter for preventing synchronization with other transmitters and with ambient periodic resident signals in the facility;

receiver means responsive to said pulse bursts by said plurality of transmitter means at each of said diverse sites in said facility for detecting infrared pulse bursts by said transmitter means; and

central means responsive to said receiver means for establishing the location of said transmitter means in said facility.

72. A locator system comprising a number of individual portable transmitter units, a number of individual stationary receiver units, and central data processing means;

said transmitter units each comprising infrared transmission means and programmable microprocessor means a unique identity data stream is transmitted by each transmitter unit;

said receiver units each comprising in combination infrared receiving means and programmable microprocessor means remotely separated from and said central data processing means such that each said receiver unit has the capability to store multiple said unique identity data streams received from multiple said transmitter units and can communicate said identity data streams to said central data processing means.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

| | | |
|----------------------|-----------|---------------|
| Haner | 3,403,381 | Sep. 24, 1968 |
| Guest et al. (Guest) | 4,990,892 | Feb. 5, 1991 |
| Warren | 5,206,637 | Apr. 27, 1993 |
| Mufti et al (Mufti) | 5,363,425 | Nov. 8, 1994 |

"Understanding Data Communication," Radio Shack, pp 5-2 and 5-12 to 5-15, Copyright 1984.

Claims 72-77, 79-80, 82-87, 89-90, 92-97, 99-100¹ stand rejected under 35 U.S.C. § 112, paragraph 1, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 49, 50, 53-55, 57-65, 67, 69 and 70 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guest in view of Mufti and Haner. Claims 49-65, 67 and 69-71 stand rejected under 35 U.S.C. § 103 as being unpatentable over guest in view of Mufti and Haner further in view of Warren. Claims 66 and 68 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guest in view of Mufti, Haner, Warren, and "Understanding Data Communications"

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 37, mailed May 23, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 36, filed Feb. 8, 2001) and reply brief (Paper No. 39, filed Jul. 18, 2001) for appellants' arguments thereagainst.

¹ Here, we note that appellants have substantially copied the claims from Frederickson et al. 5,627,524, issued May 6, 1997, in an attempt to provoke an interference. We make no determination with respect to these claims beyond the enablement issue.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 112, FIRST PARAGRAPH

The examiner maintains that appellants' were not in possession of the claimed invention and that appellants' specification only describes one code and not the claimed multiple unique identity data streams received from multiple said transmitter units. (See answer at page 4.) As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the language of independent claim 72 which states:

said receiver units each comprising in combination infrared receiving means and programmable microprocessor means remotely separated from and said central data processing means such that each said receiver unit has the capability to store multiple said unique identity data streams received from multiple said transmitter units and can communicate said identity data streams to said central data processing means.

While we do not find express support for this limitation, appellants have identified various portions of appellants' specification (See brief at page 16-18 and reply at pages 2-3) which tend to support appellant's contention that "each said receiver unit has the

capability to store multiple said unique identity data streams received from multiple said transmitter units and can communicate said identity data streams to said central data processing means.” [Emphasis added.] Furthermore, it would appear that the capability to output one code would be present while a different code is input and or being processed thereby supporting the limitation. Therefore, we do not find this argument by the examiner as persuasive. The examiner further maintains that the claims contain limitations drafted in means plus function format and that the receiver and processor of the Fredrickson et al. patent (5,627,524), from which the claim were copied, are not supported by appellants’ specification. We do not find this argument material to whether appellants’ were in possession of the claimed invention at the time of filing since the claimed “means” are only interpreted in light of the instant specification and its equivalents without reference to the Fredrickson et al. patent.² Therefore, we do not find this argument persuasive by the examiner, and we do not find that the examiner has established a **prima facie** case of a lack of possession of the invention set forth in independent claim 72. Similarly, we do not find that the examiner has established a **prima facie** case of a lack of possession of the invention set forth in independent claims 82 and 92. With respect to independent claim 82, the examiner maintains that

² We do note that the corresponding structure, acts, and materials to the recited means in the claims of the Fredrickson et al. patent would be relevant to the examiner’s consideration of the claims definiteness under 35 U.S.C. § 112, second paragraph and interpretation of the limitations under 35 U.S.C. § 112, sixth paragraph in the determination in the initial stage of an interference proceeding.

the number of microprocessor means and the number of receiver means would not be the same since the arbiter stores the multiple unique codes and this would introduce a second microprocessor in addition to the one in the receiver. Here, the examiner appears to vary the interpretation of the receiver unit and interpret it in a manner inconsistent with appellants' specification. Therefore, we do not find that the examiner has established a ***prima facie*** case of a lack of possession of the invention set forth in independent claims 82. With respect to independent claim 92, the examiner maintains that appellants do not have support for the paired relationship of the infrared sensor and microprocessor as argued with respect to claim 82. As discussed, above we do not find that the examiner has established a ***prima facie*** case of a lack of possession of the invention set forth in independent claim 82 and similarly do not find that the examiner has established a ***prima facie*** case of a lack of possession of the invention set forth in independent claims 92. Therefore, we will not sustain the rejection of independent claims 72, 82, and 92 and their respective dependent claims.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See *In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" **In re Zurko**, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Furthermore, "the Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." **In re Lee**, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). Here, we find the Examiner's arguments to be supported merely by the Examiner's own expertise or

opinion instead of the evidence of record and the teachings of prior art which are required in order to establish a *prima facie* case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of any of the independent claims 49 and 65 and their respective dependent claims over Guest, Mufti and Haner.

The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Guest, Mufti and Haner to incorporate an algorithm into the transmitter to control the transmission at random times as suggested by Mufti and Haner. (See answer at pages 6-7.) Appellants argue that the examiner's combination is based upon improper hindsight. (See brief at pages 10-13.) We generally agree with appellants arguments and do not find an adequate rationale to combine the teachings of Mufti and Haner with respect to RF process with the IR processing of Guest. Additionally, we do not find that the combination of teachings even if combined would teach or suggest the invention as claimed. Rather than just a random transmission, independent claim specifically requires that "the amount of said varying being controlled by said means responsive to an algorithm incorporated in each transmitter using said unique binary identification code of that transmitter for preventing synchronization with other transmitters and with ambient periodic resident signals in the facility." We find no teaching of the interaction of the unique identification with an algorithm to provide the recited functionality.

Therefore, we do not find that the examiner has established a ***prima facie*** case of obviousness and we will not sustain the rejection of independent claim 49 and its dependent claims. For the same reasons, we do not find that the examiner has established a ***prima facie*** case of obviousness, and we will not sustain the rejection of independent claim 65 and its dependent claims.

With respect to the examiner's addition of Warren to the base combination, the examiner has not relied upon the teachings of Warren or "Understanding Data Communications," to remedy the noted deficiencies. The examiner maintains that Warren teaches the use of microcode and storage of identification codes, but this teaching does not remedy the deficiency in the use of an algorithm in combination with stored codes to vary the transmission times, and we do not find any clear teachings which would remedy the noted deficiencies. Therefore, we will not sustain the rejection of the independent claims 49 and 65 and their dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 72-77, 79-80, 82-87, 89-90, 92-97, 99-100 under 35 U.S.C. § 112, first paragraph is reversed, and the decision of the examiner to reject claims 49-71 under 35 U.S.C. § 103 is reversed.

REVERSED

Maashid D. Saadat
MAHSHID D. SAADAT
Administrative Patent Judge

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